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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,690	11/10/2000	Chris Carmichael	259/013	5681

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LYON & LYON LLP
633 WEST FIFTH STREET
SUITE 4700
LOS ANGELES, CA 90071

EXAMINER

JAKETIC, BRYAN J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,690

Applicant(s)

CARMICHAEL ET AL.

Examiner

Bryan Jaketic

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. Examiner did not consider the Dennis reference (cite no. AF) in the Information Disclosure Statement, because a page was missing from the reference. Examiner has instead enclosed a complete copy of the Dennis reference with this Office Action and has included it on the References Cited (PTO-892). No further action by Applicant is necessary.

Claim Objections

2. Claim 5 objected to because of the following informalities: in the last line of the claim, "he" should presumably be --the--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In line 7 of the claim, the phrase "if necessary" renders the claim indefinite because it is unclear whether the limitations preceding the phrase are part of the claimed invention. See MPEP § 2173.05.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Garg. Garg discloses a method of providing sales statistics comprising the steps of receiving shipment information and sales information; maintaining the shipment information; and analyzing the information to determine statistics on sales, wherein such statistics are used to generate future orders (col. 10, lines 1-33). These statistics are provided to the retailer, since the retailer generates them. Sales statistics are also provided to the manufacturer, since the order is a function of the sales statistics. Garg does not disclose the use of a database to store the shipment and sales information. However, Garg states that the inventory data is updated (col. 10, lines 10-15). In order to update data, it is inherent that the data must have been stored in an area. Webster's dictionary defines a database as "a usually large collection of data organized especially

for rapid search and retrieval (as by a computer)". Therefore, the area in which the data is stored is a database by definition. It is therefore inherent that Garg must employ a database for the sales and shipment information.

Regarding claim 20, since the replenishment order generation system generates orders for a specific store, it is inherent that the actual sales are categorized by store. Since each store is located in a geographic territory, the actual sales are thereby categorized by geographic territories.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garg. Garg discloses all of the limitations of the claim except for a teaching of providing the statistics to manufacturers or retailers requesting the statistics. It is common in the art to provide sales statistics to a requesting entity, because such statistics are valuable information. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide statistics to a requesting entity to foster a business relationship with the entity.

10. Claims 8-11 rejected under 35 U.S.C. 103(a) as being unpatentable over Fetto in view of Dennis. Fetto discusses a web site from which a customer may remotely order an item. The customer may then pick up the item from the nearest store or have it shipped to her home (p. 2, first paragraph).

Fetto does not disclose the steps of providing a terminal at a retail location or the steps of processing funds. However, it is common in the art to provide internet terminals at retail locations, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of providing an internet terminal at a retail location in combination with the disclosure of Fetto because such internet terminals generate additional revenue. It is also common in the art e-commerce to receive payment information, convert the payment information to an electronic debit format, and providing funds to the manufacturers. It would have been obvious to one of ordinary skill in the art to employ such steps with the disclosure of Fetto to facilitate the remote ordering process.

Fetto does not disclose the steps of identifying a retail location that has stock of the product and that is located proximally to the user, transmitting the identified retail location to the terminal, and displaying it to the user. Dennis discusses an Internet site that transmits to users retail locations that are located proximally to the user and have stock of the product requested (p. 2, first and second paragraphs). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Dennis with the system discussed by Fetto to only transmit retail locations that actually have the product in stock.

11. Claims 1-7 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fetto in view of Dennis and Garg. Fetto and Dennis disclose the steps of receiving a request for a product, determining an appropriate retailer, submitting the request to the retailer, and allowing the customer to chose to have the product shipped to her or to pick it up from the retailer. Fetto and Dennis do not disclose the step of providing a code to the consumer. However, it is common in the art at the time the invention was made to provide customers with an order number upon completion of an order. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the consumer and the retailer with a code to enable the retailer to provide the customer with the ordered product.

Fetto and Dennis do not disclose an inventory management system. Garg discloses an inventory management system as described in paragraph 6 of this Office Action. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the inventory management system of Garg with the

combination of Fetto and Dennis to ensure that the specified retail location does have the product in stock.

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dennis, Fetto, and Garg as applied to claim 1 above, and further in view of Rogers et al.

Dennis, Fetto, and Garg disclose all of the limitations of the claim except for the steps of returning a product. Rogers et al disclose a product transaction system having a process for returning a product comprising the steps of allowing the customer to return the product to the retailer, receiving a notification from the retailer, and updating the sales report (col. 8, line 58 through col. 9, line 31).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kenney discloses a system for ordering products from a retailer. Kargman et al disclose a system for locating a retail store.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Jaketic whose telephone number is (703) 308-0134. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

bj
May 16, 2002

Handwritten signature of Robert P. Olszewski, dated 5/17/02.

ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600